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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/615,663

07/09/2003

Edward L. Jones

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06/10/2004

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EXAMINER

STULTZ, JESSICA T

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/615,663	Applicant(s) JONES, EDWARD L.	
	Examiner Jessica T Stultz	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) 1-17 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>0604</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0603 and 1103</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, drawn to a lens having a centration mark, classified in class 351, subclass 159.
- II. Claims 11-17, drawn to method of making a lens centration mark, classified in class 351, subclass 177.
- III. Claims 18-25, drawn to a method of measuring centration of a lens, classified in class 351, subclass 178.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by another and materially different process. Specifically, the lens can be made without filling a lens mold with a curable material.

Inventions III and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different process without

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placing the lens on a platen and rotating the lens around a rotation axis or comparing first and second centration marks at different locations.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for any one group is not required for any other group, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Group IIIa, claims 18-21, which discloses a method of analyzing the centration of a lens, specifically by leveling the lens relative to a plane of rotation orthogonal to the rotation axis of a platen and rotating the lens about the rotation axis and Group IIIb, claims 22-25, which discloses a method of analyzing the centration of a lens, specifically by positioning the lens in a first position and a second position and comparing the centration marks at the first and second locations.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Jay Pralle on June 1, 2004 a provisional election was made with traverse to prosecute the invention of Group IIIa, claims 18-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 and 22-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollmann et al in view of Abrams.

Regarding claim 18, Hollmann et al discloses a method of measuring centration of a lens (Abstract and Column 5, lines 44-56 and Column 6, lines 15-23), the method comprising: placing the lens on a platen (Column 4, lines 15-49, wherein the lens "12" is placed on a platen "16", Figures 1-4), wherein the lens comprises a first major surface and a second major surface (Shown in Figures 1-4, wherein the lens "12" has 2 major surfaces), wherein the first major surface is rotationally symmetrical about a first axis (Figures 1-4, wherein the lens surface is rotationally symmetric about the central axis through the center of the lens); and further wherein the first major surface is placed on the platen such that the intersection of the first major surface and the first axis is aligned with a rotation axis of the platen (Column 4, lines 15-49, wherein the intersection of the first major surface and the first axis, i.e. the central axis, is aligned with the rotation axis of the platen "16", i.e. the central axis, Figures 1-4); leveling the lens relative to a plane of rotation that is orthogonal to the rotation axis of the platen (Shown in Figures 1-4, wherein the lens "12" is leveled orthogonally relative to the rotation axis of the platen "16"); rotating the lens about the rotation axis of the platen (Column 4, lines 15-49, wherein the platen "16" rotates the lens "12", Figures 1-4); and observing the lens during or after rotation to assess the centration of the first major surface of the lens (Abstract and Column 5, lines 44-56 and Column 6, lines 15-23, wherein the deviations of the lens "12" are observed when the lens is rotated and the centering error, i.e. centration is determined, Figures 1-4), but does not specifically disclose that the first major surface comprises a first lens centration mark located at the intersection of the first major surface and the first axis. However, Abrams teaches of a lens

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having a centration mark located at the intersection of the first major surface and the first axis (Column 5, lines 11-49, wherein the lens “15” has ink marks to align with pins “32”, wherein the center mark is located at the optical center of the lens aligned with the axis “35”, Figures 1-2 and 6), wherein the first major surface is placed on a platen such that the centration mark is aligned with a rotation axis of the platen (Column 4, lines 44-55 and Column 5, lines 11-49, wherein the lens “15” aligns with the rotatable holder “30”, Figures 1-2 and 6) for the purpose of properly arranged on the rotatable holder in alignment with the axis (Column 5, lines 11-49). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of measuring centration of Hollmann et al further include the first major surface of the lens having a first lens centration mark located at the intersection of the first major surface and the first axis since Abrams teaches of a lens having a centration mark located at the intersection of the first major surface and the first axis, wherein the first major surface is placed on a platen such that the centration mark is aligned with a rotation axis of the platen for the purpose of properly arranged on the rotatable holder in alignment with the axis.

Regarding claim 19, Hollmann et al and Abrams disclose and teach of a method of measuring centration of a lens as shown above and Hollmann et al further discloses steps of measuring a maximum distance from a reference point to an outer edge of the lens as the lens rotates; measuring a minimum distance from the reference point to the outer edge of the lens as the platen and lens rotate (Column 5, lines 31-56, wherein the maximum and minimum sine values are determined by the sensor “20”, Figures 1-4); and comparing the minimum distance and the maximum distance (Column 5, lines 31-56 and Column 6, lines 15-38, wherein the maximum and minimum values are compared to determine the centering error, Figure 7).

Regarding claims 20-21, Hollmann et al and Abrams disclose and teach of a method of measuring centration of a lens as shown above, but do not specifically disclose repositioning the lens on the platen so that a second centration mark is aligned with the rotation axis to access the centration of a second surface. It would have been obvious to one having ordinary skill in the art at the time the invention was made for the method of measuring the centration of the surface of a lens be used to measure an additional surface of the lens, since it is well known in the art of testing lenses to test both sides of the lenses for the purpose of determining the optical characteristics of each lens in its entirety and to determine the optical capabilities of each lens.

Conclusion

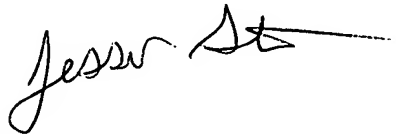
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bowen, Bouwhuis et al, and Taguchi are cited since they disclose the testing of both surfaces of to determine the optical characteristics of the entire lens. It is noted that applicant cited Beebe et al also discloses testing of both surfaces of to determine the optical characteristics of the entire lens.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica Stultz
Patent Examiner
AU 2873
June 3, 2004



JORDAN SCHWARTZ
PRIMARY EXAMINER